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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,396

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Philipp Stossel

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EXAMINER

WILSON, MICHAEL H

ART UNIT

PAPER NUMBER

4145

MAIL DATE

DELIVERY MODE

04/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,396	Applicant(s) STOSSEL ET AL.	
	Examiner MICHAEL H. WILSON	Art Unit 4145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,7,9,11,13,14,16-18 and 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8,10,12 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20050223; 20070717</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-13, and 15, and of species of inventive example 1 (page 20 of the specification), claims 1, 4-6, 8, 10, 12, and 15, in the reply filed on 26 March, 2008 is acknowledged. The traversal is on the ground(s) that distinctiveness has not been established in particular see MPEP 803 that the claims, as written, do not constitute a search burden. This is not found persuasive because applicant's argument re. burden of proof to establish distinctness, in particular MPEP 803 are not germane to the lack of unity of invention, as set forth in Office Action mailed 02/26/2008.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 14, 16-18, and 22-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed on 26 March, 2008.

3. Claims 2, 3, 7, 9, 11, and 13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 26 March, 2008.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4-6, 8, 10, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuboyama et al. (US 2003/0068536 A1).

Regarding claim 1 and 4, Tsuboyama et al. disclose the compound of formula (I) wherein M is Ir, Y is R-C=C-R, and Ar is phenyl (page 12: table 16, compound 512; table 17 compound 523).

Regarding claims 5, 6, 8, 10 and 12, Tsuboyama et al. discloses all the claim limitation as set forth above. Additionally the reference discloses wherein:

- b = 0 (page 12; table 17, compound 523);
- characterized in that the radical Ar is biphenyl (page 12; table 17, compound 523; and [0162])
- Ar is an aryl group (page 12; table 17, compound 523);
- Ar is phenyl (page 12; table 17, compound 523);
- and M =Ir (page 12; table 16, compound 512; table 17, compound 523);

Regarding the radical of Ar, synthesis of the ligand is described in [0162] which defines R5 and R6 (of sPh) as H and phenyl, respectively.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuboyama et al. (US 2003/0068536 A1) as applied to claim 1 above.

Regarding claim 15, Tsuboyama et al. discloses all the claim limitation as set forth above. The reference does not explicitly disclose the purity of the compounds. However it would be obvious to one of ordinary skill in the art at the time of the invention to purify the compounds of Tsuboyama et al. using methods well known in the art to obtain a purity of 99%. Since the instant specification is silent to unexpected results, purity is not considered to confer patentability to the claims. As the product properties are a variable(s) that can be modified, among others, by product purity, the precise

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purity would have been considered a result effective variable by one having ordinary skill in the art at the time the invention was made. As such, without showing unexpected results, the purity of the compound cannot be considered critical.

Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine experimentation, the purity of the compounds in the device of Tsuboyama et al to remove undesired impurity emission and obtain desired product properties (*In re Boesch*, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (*In re Aller*, 105 USPQ 223).

Miscellaneous

9. The reference citation on page 3, line 1 of action mailed 02/26/2008 contained an error. The correct citation is US 2003/0068536 A1, which was correctly recorded on PTO-892 mailed with the action.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Igarashi et al. (US 2001/0019782 A1) contains iridium compounds closely related to applications disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. WILSON whose telephone number is

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(571)270-3882. The examiner can normally be reached on Monday-Thursday, 7:30-5:00PM EST, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Basia Ridley can be reached on (571) 272-1453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MHW

/Basia Ridley/
Supervisory Patent Examiner, Art Unit 4145